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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,784	10/11/2005	Lawrence David McCarthy	B-5682PCT 622598-3	9968

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LADAS & PARRY
5670 WILSHIRE BOULEVARD, SUITE 2100
LOS ANGELES, CA 90036-5679

EXAMINER	
GRABOWSKI, KYLE ROBERT	
ART UNIT	PAPER NUMBER
3725	

MAIL DATE	DELIVERY MODE
06/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,784	MCCARTHY ET AL.	
	Examiner	Art Unit	
	Kyle Grabowski	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-82* is/are pending in the application.

4a) Of the above claim(s) *22-35* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21 and 36-82* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 April 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *03/21/06, 07/26/06, 10/02/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in the reply filed on 03/02/09 is acknowledged. The traversal is on the ground(s) that there is no serious burden to the examiner to rejoin groups IV and V with elected group I. This is found persuasive because upon further consideration there doesn't appear to be a serious burden of search to rejoin these groups as no significant structural differences are present.

2. Groups II and III, however, present a significant divergent structural differences (or at least functional limitations which owe to structural differences) that would require a burdensome search. A phone call with the attorney of record presented a new election requirement between Groups II and III, (Groups I, IV, and V, being generic) and an election of Group III was made of claims 36-45.

3. Claims 22-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 33-35, though erroneously omitted from Group II are dependent upon claim 22 and also withdrawn. Election was made **without** traverse via telephonic interview on 06/02/09.

4. Claims 1-21 and 36-82 are hereby examined on their merits.

Claim Objections

5. Claims 7 and 8 objected to because of the following informalities: each has typographical errors: "…each image element is in the range [of]..." and "…each image element is in the [range of]...". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 21 and 45, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It contends that the image elements are chosen to vary such that they appear the same size, which is contradictory. For prosecution on their merits, "the primary image elements" will be construed to mean "the primary images".

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-6, 10-12, 21, 36, 41, 45-51, 55-56, 63-64, 68-75, 79-80, and 82, are rejected under 35 U.S.C. 102(b) as being anticipated by Atkinson et al. (US 4,897,802).

10. In respect to claims 1-3 and 10, Atkinson et al. disclose a device (purposes of security are only an intended use of the invention) comprising: a secondary image 61 comprising a plurality (four) primary images 71, 73, 75, and 77, formed of a plurality of regularly sized and spaced apart primary image elements 62, 64, 66, and 68 (Fig. 2) and a separate decoding mask 63 formed of transparent viewing portions 65 (Fig. 5); the size and spacing of the viewing portions 65 being such that when said viewing portions 65 of the mask 63, said secondary image 61 and an observer are located in one or more predetermined alignments for each said one or more encoded primary images, the primary image elements from the secondary image may be observed through the viewing portions, whereby the corresponding primary image may be observed along a line of sight corresponding to said predetermined alignment (Col. 3, 31-41).

11. In respect to claims 4-6, the primary images 71, 73, 75, and 77 may be perceived as animated, for example provided as "pattern of copy from a single advertiser" (Col. 11, 30-38).

12. In respect to claims 11 and 12, the mask 63 includes N (four) primary images (71, 73, 75, and 77) and N-1 (three) masking portions ‘B’, ‘C’, ‘D”, for each (one) viewing portion ‘A’ (Fig. 5); the mask further comprises opaque horizontal and vertical lines forming the masking portions (Col. 5, 46-50).

13. In respect to claims 21 and 45, as best understood by the examiner, the image elements are varied in size (some are smaller near the border) and regardless, the primary elements appear to be about the same size.

14. In respect to claims 36 and 41, Atkinson et al. disclose the claimed subject matter for the reasons stated above (i.e. although there are four primary images, the selected one which is solely shown is the one "containing information of interest").

15. In respect to claims 46-51, 55-56, 75, Atkinson et al. disclose the claimed subject matter for the reasons stated above (i.e. the device is *adapted* to be secured to a item, to provide security, again, is intended use of the invention).

16. In respect to claims 63 and 64, the screen 35 may be constructed of a lined transparent film with "the space between the [printed] lines forming the apertures" (Col. 4, 58-64). The mask 63 may be fabricated the same way (Col. 6, 63-64). The film therefore is acts as a transparent separator between the secondary image and the mask (printed line material).

17. In respect to claims 68-74 and 79-80, Atkinson et al. disclose the claimed subject matter for the reasons stated above.

18. In respect to claim 82, the device taught in Atkinson et al. is capable of this functionality.

19. Claim 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Sebastian (US 4,221,064). Sebastian discloses a device (purposes of security are only an intended use of the invention) comprising: a secondary image 12 comprising one

primary image, a calendar, formed of a plurality of regularly sized and spaced apart primary image elements (“1” through “30") (Fig. 5A) and a separate decoding mask 10 formed of transparent viewing portions 11 (Fig. 1); the size and spacing of the viewing portions being such that when said viewing portions 11 of the mask 10, said secondary image 12 and an observer are located in one or more predetermined alignments for each said one or more encoded primary images, the primary image elements from the secondary image may be observed through the viewing portions, whereby the corresponding primary image may be observed along a substantially perpendicular line of sight corresponding to said predetermined alignment (Abstract). The device further includes a blocking mask 13 spaced via spacers 14 from the mask 10 and also secondary image 12 (the secondary image can slide freely and therefore is not firmly abutted thereto).

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

21. Claims 46 and 67 are rejected under 35 U.S.C. 102(a) as being anticipated by Ahlers et al. (US 2005/0057036). Ahlers et al. disclose a device (purposes of security are only an intended use of the invention) comprising: a secondary image 3 comprising a primary image formed of a plurality of regularly sized and spaced apart primary image (line screen) and a separate decoding mask 2 formed of transparent viewing portions

(between a printed dot screen) (0063, Fig. 1); the size and spacing of the viewing portions being such that when said viewing portions of the mask, said secondary image and an observer are located in one or more predetermined alignments for each said one or more encoded primary images, the primary image elements from the secondary image may be observed through the viewing portions, whereby the corresponding primary image may be observed along a line of sight corresponding to said predetermined alignment (i.e. at least portions of the primary image are viewable through transparencies in the mask 2 while creating the moiré pattern); both the mask 2 and secondary image 3 are provided on a single piece of material 3 at spaced apart locations such that the material 3 may be folded to locate the mask 2 over secondary image 3 (0013).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. Claims 7-9, 38-40, 44, and 52-54, are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. (US 4,897,802).

25. In respect to claims 7, 38, and 54, Atkinson et al. substantially disclose the claimed subject matter for the reasons stated above but do not disclose each of the image elements having a side length between 0.1 μm and 200 μm but rather slightly larger (0.013 inches or ~330 μm) however it would have been obvious to one of ordinary skill in the art at the time the invention was made to alter the dimensions of image elements, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Moreover, it is disclosed in Atkinson et al. that the image elements may be increased in size on application wherein the viewer is disposed further away (e.g. 25 ft away vs. 10 ft away) (Col. 12, 3-9) and it would not be out of the technical grasp of one of ordinary skill to realize that similarly a closer viewing distance (e.g. <10 ft away) would require smaller image elements for equal effect.

26. In respect to claims 8-9, 39-40, and 52-53, obviously altering the image elements to an optimal range, for example, 50 μm, would result in 2500 sq μm image elements (2.5 x 10^-9 m^2).

27. In respect to claim 44, this is a function limitation which is completely dependent on the "digital image acquirer". Old digital image acquirers would have defaulting capturing images of the size stated above.

28. Claims 13-15, 20, 57-60, and 76-78, are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. (US 4,897,802). Atkinson et al. substantially disclose the claimed subject matter for the reasons stated above, including various means of imparting color to the primary images (Col. 7, 43-Col. 8, 43) however does not disclose particular color arrangements (e.g. choosing the color of the primary images to "enhance the effect" of alignment, or all of the primary images formed from different colors) however it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Atkinson et al. with any available ink colors. The claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. Providing colors is already taught explicitly by Atkinson, and the selection of particular colors is a technique well known to one in the printing art.

29. Claims 16-17 and 61-62, are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. (US 4,897,802) in view of Hines (US 3,914,877). Atkinson et al. substantially disclose the claimed invention for the reasons stated above but do not disclose areas of the secondary image bordering the primary images being comprised of randomly selected obscuring image elements however Hines discloses a

similar invention which utilizes random code patterns (Fig. 1E) outside of the primary image 14 (Fig. 1G) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device taught in Atkinson et al. with random code patterns so that no meaningful image can be discerned without a mask (code plate) (Col. 2, 43-51).

30. Claims 18-19, 42-43, 65-66, and 81, are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al. (US 4,897,802) in view of Cummins et al. (US 5,980,011). Atkinson et al. substantially disclose the claimed invention for the reasons stated above but do not disclose providing the mask or secondary image within a transparent material however Cummins et al. disclose lamination (providing an upper layer of transparent material) (Col. 1, 22-24) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the mask and/or secondary image taught in Atkinson et al. with lamination in view of Cummins et al. to protect the printed information therein (Col. 1, 22-24).

Conclusion

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/
Examiner, Art Unit 3725

/Dana Ross/
Supervisory Patent Examiner, Art Unit 3725